

**LERNER GREENBERG STEMER LLP**  
AN INTELLECTUAL PROPERTY LAW FIRM  
REGISTERED PATENT ATTORNEYS AND AGENTS

2445 Hollywood Boulevard  
Hollywood, Florida 33020  
Tel. 954-925-1100  
Fax 954-925-1101

Laurence A. Greenberg (FL Bar)  
Werner H. Stemer (FL Bar)  
Ralph E. Locher (FL, IL, MO Bars)

Otto S. Kauder (Reg. Pat. Agent)  
F. Donald Paris (NY, NJ, DC Bars)  
Alfred K. Dassler (Reg. Pat. Agent)  
Kerry P. Sisselman (IN Bar)

PATENTUSA@  
www.patentusa.com  
patents@patentusa.com  
trademarks@patentusa.com

Mailing Address:  
Post Office Box 2480  
Hollywood, FL 33022-2480

RECEIVED  
CENTRAL FAX CENTER  
DEC 28 2006

Satellite Office  
153 E 57th St., Suite 15G  
New York, NY 10022

Of Counsel:  
Herbert L. Lerner (NY Bar)  
David W. Barman (FL Bar)

Ihr Zeichen: P 03 131 US 01  
Unser Zeichen: AMB-131-01

28 December 2006

Patentanwalt Dipl.-Phys. Alexander M. Bach  
Postfach 300 222  
D-50772 Köln  
Germany

Betr.: Wolfgang Els et al. - U.S. Patentanmeldung  
Aktenzeichen 10/770.616

Sehr geehrter Herr Bach:

Mittlerweile erhielten wir den in unserem Fax vom 20. Dezember genannten Bescheid des Prüfers per Post. Da Sie bereits Gruppe I ausgewählt haben, ist hierzu keine weitere Aktion von Ihnen nötig. Den Bescheid legen wir lediglich fuer Ihre Unterlagen bei. Ihren Anweisungen gemäß haben wir die beigelegte Antwort bei dem US Patentamt eingereicht.

Wir werden Sie über die weiteren Entwicklungen in diesem Fall informieren.

Mit freundlichen Grüßen und den besten Wuenschen fuer das Neue Jahr;

  
Laurence A. Greenberg  
Anlage : Prüfbescheid & Antwort  
/bh

RECEIVED  
CENTRAL FAX CENTER

DEC 28 2006



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,616	02/02/2004	Wolfgang Eis	AMB-131-01	2302

24131 7390 12/22/2006  
LERNER GREENBERG STEMER LLP  
P O BOX 2480  
HOLLYWOOD, FL 33022-2480

EXAMINER

DEGHAN, QURENTE S

ART UNIT

PAPER NUMBER

1731

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
	12/22/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

DEC 28 2006

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/770,616	EIS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Queenie Dehghan	1731	

~ The MAILING DATE of this communication appears on the cover sheet with the correspondence address ~  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-42 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

RECEIVED  
CENTRAL FAX CENTER  
DEC 28 2006

Application/Control Number: 10/770,616  
Art Unit: 1731

Page 2

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-26, drawn to an apparatus for making optical fiber, classified in class 65, subclass 486.
  - II. Claims 27-42, drawn to method for drawing and coating optical fibers, classified in class 65, subclass 381.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group II and Group I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process, such as winding yarn.
3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required

Application/Control Number: 10/770,616  
Art Unit: 1731

Page 3

because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

5. A telephone call was made to Laurence Greenberg on December 14, 2006 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

Application/Control Number: 10/770,616  
Art Unit: 1731

Page 4

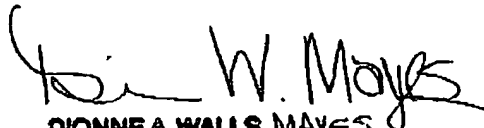
or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Queenie Dehghan whose telephone number is (571)272-8209. The examiner can normally be reached on Monday through Friday 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Q Dehghan

  
DIONNE A. WALLS MAYES  
PRIMARY EXAMINER